REMARKS

Applicants would like to thank the Examiner for the careful consideration given this Application and the allowance of Claims 16 and 17. Claims 1, 7-12 and 13-17 are pending. No amendments to the claims are submitted at this time.

Claim Rejection under 35 U.S.C. 102(b)

Claims 1 and 7-12 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,393,816 to Kondo et al. (hereinafter "Kondo").

The Examiner alleges that Kondo discloses compositions containing rubber and mixtures of rubbers, amino alcohols, and filler and, therefore, anticipates independent Claim 1. Applicants respectfully disagree.

It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See *Motorola Inc. v. Interdigital Technology Corp.* 43 USPQ2d 1481 (1997 CAFC).

Applicants submit that Kondo fails to disclose the method of independent Claim 1 in sufficient clarity to prove its existence. In particular, Kondo teaches the following composition: a rubber; an amino alcohol; a glycol; an absorptive; and optionally, an organic filler (column 2, lines 31-39). In contrast in the method of independent Claim 1, the following compounds are admixed and cured: a halobutyl elastomer; particles of filler; and an additive. Kondo provides no evidence that a filled halobutyl elastomer consisting essentially of a halobutyl elastomer, filler and an additive ever existed.

Moreover, a skilled artisan attempting to produce a polymer with improved tear strength and abrasion resistance for use in tire tread and the interliner of tires, as described in the current claimed invention, would not add an absorptive in the formulation. For example, the molds used to produce tire tread become dirty after repeated use. The addition of an absorptive to a polymer used to make tire tread would

absorb the residue on the mold adding irregularities to the tread and reducing the quality of the final polymer. A tire tread containing an absorptive would also be expected to absorb particles on the roads on which the tire travels. Here again, one of ordinary skill in the art would expect the absorption of particles from roads to cause the tear strength and abrasion resistance to deteriorate over time reduce the life of the tire tread.

Furthermore, glycol is generally considered a wetting or softening agent when used as an additive in rubber based polymers and adds to the flowability of mold cleaning rubber articles noted by Kondo. Hence, the addition of glycol is essential to the ability of the cleaning rubber to conform to the shape of the mold being cleaned, and the removal of glycol would destroy the functionality of the rubber of Kondo. This is affirmed by the tear strength and abrasion resistance of the filled halobutyl elastomers of independent Claim 1. In fact, one of ordinary skill in the art would not expect these qualities to be as pronounced as in these filled halobutyl elastomers and would characterize these results as surprising.

Additionally, Kondo fails to teach or suggest a process by which a halobutyl elastomer, filler and an additive are admixed and then cured as recited in independent Claim 1. In particular, Kondo clearly states that various additives, including fillers, may be "compounded into the composition" (column 6, lines 15-17). Kondo, therefore, teaches the steps of preparing the rubber composition; compounding in of the additive; and curing the rubber. Independent Claim 1 does not require the additional compounding step.

Accordingly, Kondo fails to anticipate the process of independent Claim 1, and the Examiner's rejection under 35 USC 102(b) should be withdrawn.

Claims 7-12, either directly or indirectly, depend from and add further limitations to independent Claim 1 and are, respectfully, deemed allowable at least in combination with the reasons of independent Claim 1. Reconsideration is respectfully requested.

Claim Rejection under 35 U.S.C. § 103(a)

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (Fed. Cir. 1974)". Applicants also respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure." See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

As discussed above, Kondo fails to teach or suggest the process of independent Claim 1. In particular, Kondo fails to teach or suggest a composition that does not contain glycol and an absorptive and fails to teach or suggest a process in which the filler is admixed with a halobutyl elastomer and an additive and this composition is cured. Accordingly Kondo fails to teach or suggest the process of Claim 1 and, therefore, cannot teach or suggest dependent Claims 14 and/or 15 which add further limitations to independent Claim 1. Reconsideration is respectfully requested.

It is believed that the pending claims are now in condition for allowance and notice to such effect is respectfully requested. Should the Examiner have any questions regarding this application, the Examiner is invited to initiate a telephone conference with the undersigned.

Respectfully submitted,

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